

## REMARKS

Claims 1-20 and 22 are in this case. Claim 21 has been cancelled without prejudice. Claim 22 is new. No new matter has been added. The number of claims and the number of independent claims have not increased. Accordingly, it is believed that no additional fees are due.

### *Claim Rejection – 35 USC § 103*

Claims 1-9 were rejected under 35 USC 103(a) as allegedly being unpatentable over Thorne et al. U.S. 5,958,005 in view of Higley U.S. 6,065,048. This rejection is respectfully traversed.

Applicants previously argued that neither Thorne nor Higley teach "...preprocessing said email to create a modified email that has a link to a stored image of the body from the email substituted for the body of the email..." Higley is silent about creating a link to a stored image of a body of an email and then executing the link to request the stored image to send the image to an email recipient. The Office Action does not claim Higley discloses these steps of claim 1. As to Thorne, however, the Office Action alleges that:

"In column 2, lines 51-54, Thorne discloses a recipient to copy and store the email document. The copy of the message is the image of the message, and such copy is a substitute of the document (i.e. substituting the body of the email by a link to that copy or image)."

Thorne in column 2, lines 51-54, discloses:

"Thus there is an existing need to provide to an E-Mail originator or sender the capability to control the ability of the recipient to copy, forward, print, and store the document. Still further, there is a need for an erasure procedure that goes beyond deletion and precludes recovery."

This section in Thorne is completely silent about a link, a link substituted for the body of the email, and executing the link contained in the modified email, as required by claims 1 and 8. Neither Thorne nor Higley disclose this step of claims 1 and 8. Thus, the combination of Thorne and Higley does not teach or suggest claims 1 and 8, and allowance of these claims is respectfully requested.

The Office Action also alleges that one would be motivated to combine Thorne with Higley to allow connecting to servers in the web and to provide sending and receiving documents in email

over the internet. It is respectfully pointed out that applicants refer to the SMTP standard which is an internet based email protocol, which is not claimed. One of ordinary skill would not combine Thorne, who discloses a modified mail user agent and is silent about a modified mail transport agent that modifies the body of an email, with Higley, who is also silent about a modified mail transport agent that modifies the body of an email, to arrive at an unmodified mail user agent and a modified mail transport agent that modifies the body of an email. It is respectfully pointed out that such a combination would be inoperable in the context of claims 1 and 8.

For at least the above reasons, even if the combination of Thorne and Higley taught or suggested the invention of claims 1 and 8 – which they do not do as explained above – Thorne and Higley are not properly combined under 35 U.S.C. § 103. Accordingly, allowance of claims 1 and 8 is respectfully requested.

Claims 2-7 depend upon claim 1 and claim 9 depends upon claim 8. It was shown above that neither Thorne, nor Higley nor the combination of the two references teaches or suggests claims 1 and 8. For at least that reason neither Thorne, nor Higley nor the combination of the two references teaches or suggests claims 2-7 and 9 and allowance of these claims is respectfully requested.

#### ***New Claim***

New claim 22 depends upon claim 7 and claims “wherein sender’s mail user agent is selected from a group consisting of MS Outlook<sup>TM</sup> or Eudora;” This aspect is disclosed throughout the specification, for instance on page 1, lines 18-24.

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The Examiner is invited to contact the Applicant's Representative at the below-listed telephone number if there are any questions regarding this communication. No new matter has been added.

Respectfully Submitted,

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